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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,147	12/15/2003	Mikhail Verbitsky	03-120	6335

7590 07/27/2005

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EXAMINER

LE, UYEN T

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/737,147

Applicant(s)

VERBITSKY, MIKHAIL

Examiner

Uyen T. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 4 April 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
2. It is also noted that a document entitled "Semantic TRIZ™" marked APPENDIX B had been found in this application. However it is not listed in an Information Disclosure Statement and there is no APPENDIX A.

### ***Specification***

3. The disclosure is objected to because of the following informalities: paragraph 0003 contains typographical errors.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 8, 9, 15, 19, 20, 23-33, 37, 41, 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because:

- Claim 23, line 5 "the computer program" lacks antecedent basis

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- Claim 4, line 5, 6, claim 15, line 6, claim 26, line 6, claim 37, line 6 “the search results” lack antecedent basis
- Claim 4, last line, claim 15, line 7, claim 26, line 7, claim 37, line 7 “the recurrent different specific criteria” lack antecedent basis.

Art rejection is applied to claims 23-25, 27-29, 32, 33 as best understood in light of the rejection under 35 U.S.C. 112, second paragraph discussed above.

Art rejection is not being applied to claims 4, 8, 9, 15, 19, 20, 26, 30, 31, 37, 41, 42 because the limitations cannot be ascertained.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3, 12, 14, 23, 25, 34, 36 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's admitted prior art (AAPA) at paragraphs 0004-0006).

Claim 1 merely reads on the method performed by AAPA TechOptimizer described in paragraphs 0004-0006. The computer is clearly specially programmed since TechOptimizer is a software suite. The TechOptimizer clearly accepts a natural language query which is a restatement of a contradiction having at least two contradictory elements and at least two semantic items as part of each contradictory element. The database has to be semantically indexed since query is submitted in

natural language. The response has to be communicated to the computer for display to the user as shown in Figure 2.

Claim 12 corresponds to a system for performing the method of claim 1, thus is rejected for the same reasons stated in claim 1 above.

Claim 23 merely differs from claim 1 by reciting "formulating by a portion of the computer program a natural language query" instead of "inputting into the specially programmed computer a natural language query". Since TechOptimizer is a software package operating on a computer, clearly the natural language query is formulated by a portion of the computer program as claimed.

Claim 34 correspond to a system for performing the method of claim 23, thus is rejected for the same reasons stated in claim 23 above.

Claims 3, 14, 25, 36 are met when AAPA shows the search criteria of "Engineering" and "Physical" in Figure 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 13, 24, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (AAPA) at paragraphs 0004-0006.

Regarding claims 2, 13, 24, 35, although AAPA does not specifically show that the semantically indexed database is a patent collection, since TechOptimizer allows

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searching of semantically indexed database, it would have been obvious to one of ordinary skill in the art to include such collections as semantically indexed databases while implementing the method of AAPA in order to search intellectual properties.

7. Claims 5, 6, 7, 10, 11, 16, 17, 18, 21, 22, 27, 28, 29, 32, 33, 38, 39, 40, 43, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (AAPA) at paragraphs 0004-0006, further in view of Schultz et al (US 2003/0061211).

Regarding claims 5-7, 16-18, 27-29, 38-40m although AAPA does not specifically show specific search criteria of time interval, type of organization, geographical description, it is well known in the art as shown by Schultz to use such search criteria (see 0017, 0018). Therefore, it would have been obvious to one of ordinary skill in the art to include such search criteria while implementing the method and system of AAPA in order to provide more search options for users to select.

Regarding claims 10, 11, 21, 22, 32, 33, 43, 44, Schultz further teaches industrial designation and institutional designation when Schultz shows business information (see 0018).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Todhunter (US 2005/0114282) teach problem formulation for obtaining solutions from a database.

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Grune et al (US2003/0004936) teach simultaneous intellectual property search.

Hsu et al (US 2002/0059069) teach natural language interface and constrained optimization.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22 July 2005



UYEN LE  
PRIMARY EXAMINER